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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/780,507	01/08/97	ELLUL	M 9427C

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IM22/0913

EXAMINER
ZITOMER, F

ART UNIT	PAPER NUMBER
1713	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 08/780,507

Filing Date: January 8, 1997

Appellant(s): Maria D. Ellul et al.

MAILED

SEP 11 2001

GROUP 1700

Louis Gubinsky
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed July 6, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect

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or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment of April 20, 2001 (Paper No. 5) has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

There is a statement in the brief that all the claims stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Masuda et al., US 5,525,675.

Masuda teaches thermoplastic elastomer compositions comprising the claimed propylene homopolymer, ethylene-propylene-nonconjugated diene rubber, organic peroxide and amounts thereof [Abstract; column 3, line 53- column 4, line 30]. Propylene polymers having a syndiotactic pentad of at least 0.7, notably at least 0.85, and specifically of 0.91 *inter alia* are disclosed, exemplified and claimed [column 3, lines 26-35; column 7, lines 22-24; claims 1 and 2]. Polypropylene homopolymer containing at least 0.85 syndiotactic pentad advantageously affords excellent heat resistance and formability [column 3, lines 26-31]. The disclosures of Masuda are commensurate with the instant invention.

(11) *Response to Argument*

Throughout prosecution and in the brief appellants have not disputed that Masuda anticipates or even renders the present claims obvious. See for example page 3, ARGUMENTS, lines 3-4 of the brief. However, appellants assert that the present compositions are disclosed via inherency in the parent applications and that an interference as opposed to a rejection should be declared. The argument is not compelling because Masuda is distinguished by polypropylene homopolymers containing syndiotactic pentads as described above. The patent was allowed only after the patentee showed that polymers containing said

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pentads afford unexpected results as stated above [see e.g. the declaration of Paper No. 11 in the Masuda application]. The present application is a continuation-in-part of applications relating to compositions of the claimed polymers absent any mention or suggestion of the present pentads. At best the parent applications encompass a broad genus of polypropylenes some of which might happen to contain the claimed pentads.

In view of the stated facts the positions of the examiner and appellants are as follows:

- appellants feel that because polypropylene homopolymers containing the claimed pentads are species encompassed in the parent applications an interference should be disclosed based on inherency, i.e. that such polymers were inherently disclosed.

- the examiner feels that the advantageous properties of polypropylene homopolymers containing the claimed pentads were unknown before Masuda. Accordingly, there is no motivation prior to Masuda to select the claimed polypropylene homopolymers from the myriad polypropylene polymers disclosed by appellant. Appellants' assertion that the syndiotactic pentads of Masuda are inherent would be persuasive only if the polymers in the parent applications were limited to polypropylenes containing said pentads. Nothing on the record shows this to be the case. At best the parent applications can be said to disclose a generic class of polymers some of which may contain the instant pentads. Inherency is clearly not an issue because there is no assurance that all the polypropylene homopolymers of the parent applications would contain the claimed pentads. Therefore there are no grounds for interference.

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Appellant has cited *Kennecott Corp. V. Kyocera International Inc.* and *In re Nathan* to show precedent for inherency in instances where structure is not disclosed in an earlier application. This is not pertinent to the present case because both *Kennecott* and *Nathan* relate to instances where the inventions are limited to only a single structure, *i.e.* all species disclosed would necessarily contain the structure and would be entitled to the benefit of the earlier application. In the present case the parent applications encompass many structures and the advantageous properties of the structures now being claimed were previously unknown as stated above.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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ART UNIT 1713

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